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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/030,824 | 01/11/2002 | Klaus Weber | 1093-41 PCT/US | 2380 |

7590 10/03/2003

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| EXAMINER | |
|---|---|
| DICUS, TAMRA | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1774 | |

DATE MAILED: 10/03/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/030,824 | WEBER, KLAUS | |
| | Examiner | Art Unit | |
| | Tamra L. Dicus | 1774 | |

*-- Th MAILING DATE of this communication appears on the cover she t with the correspondenc address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *30 September 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-12* is/are pending in the application.

4a) Of the above claim(s) *11* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10 and 12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☒ Interview Summary (PTO-413) Paper No(s). *11, 12* .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

## DETAILED ACTION

### *Response to Amendment*

The 112 rejections are withdrawn due to Applicant's amendment.

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 3,922,435 to Asnes in view of USPN 5,795,425 to Brault et al. in view of USPN 5,925,431 to Schoenfelder.

Asnes teaches a dry-release heat transfer label for objects such as plastic bottles. The label is formed by a resinous release layer on a suitable temporary carrier (carrier film), with a transfer layer, including a design print on the release layer and a heat -activatable adhesive layer upon the transfer layer. Asnes explains the composition of the release layer and the transfer layer are such that at heat transfer temperatures, the relative strengths of the bonds between then and their cohesiveness, permit the release layer, with its temporary carrier, to be stripped from the transfer layer which remains adhered to the object without leaving any substantial amount of the transfer layer with the release layer. The transfer layer is preferably formed by a clear lacquer (representing "transparent replication lacquer of claim 10) printed on the release layer with a design print in registry with it and a clear adhesive layer (meeting limitations "can be printed on" of claim 4). The clear lacquer and adhesive layers desirably

contain a fluorescent dye for accurate registration during printing using ultraviolet light, meeting limitations of claim 9. Furthermore, regarding claims 4 and 10, that the transfer foil is able to be printed upon by a printer is not germane since it has been held that an element that is "being able to" perform a function (can be) is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138. Also, "a layer which at least partially covers the structure....of high refractive index..." of claim 10 is disclosed by the reference.

Asnes is silent to a permanent adhesive secured to a base foil/paper and being siliconized. Brault teaches the advantages of employing a temporary carrier layer (12) on an imaged receptor element (10). Layer (12) functions as a temporary support to the superposed layers during the process steps and may be any web or sheet material possessing suitable flexibility, dimensional stability and adherence properties to protective layer (14). The web or sheet material of (12) is a flexible polymeric film, e.g., such as polyethylene terephthalate film and the like, or a paper sheet and the like. The web or sheet may also be surface treated or coated with a material to enhance desired release characteristics, e.g., such as treatment with a silicone release agent (producing a siliconized surface). Adhesive material (16) is interdisposed between protective layer (14) and imaged layer (18). (18) is adjacent to a substrate (20) (a carrier foil). See to col. 5, lines 49-65 and col. 7, lines 29-35. Hence it would have been obvious to one of ordinary skill in the art to modify the heat transfer label of Asnes by laminating the recording element of Brault by including a permanent adhesive/paper/siliconized structure for the purpose of securing a design to a substrate, providing the aforementioned properties as cited by Brault above.

Asnes is silent to teaching a transfer label subdivided into plurality of individual elements as recited in claim 2. Schoenfelder teaches a label with integrated coding that is subdivided into a plurality of individual elements as shown in Figures 3a-7, see also col. 6, lines 34-40, and col. 7, lines 32-50. Hence it would have been obvious to one of ordinary skill in the art to modify the label of Asnes to provide separate subdivided elements in order to dispense individual transfers as taught by Schoenfelder at col. 7, lines 31-55.

While Asnes is further silent to stamping individual elements, that such elements are formed by stamping.... (claim 3) is a process limitation in a product claim. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown,* 459 F. 29 531. Moreover, Schoenfelder teaches it is known to hot-stamp labels at col. 8, lines 55-63.

Asnes is silent to teaching an optical/holographic action and a vapor deposited layer of ZnS, TiO2, SiO (claims 5-7). However, Schoenfelder teaches where a titania is provided on a paper foil for the purpose of providing conductivity to a film for protection at col. 10, lines 55-65. Since the same materials are used, the optical/holographic action and its refractive index comparison are inherent properties. Hence it would have been obvious to one of ordinary skill in the art to modify the label of Asnes to further include a vapor deposited titania layer for the purpose of protecting the label against oxidation as taught by Schoenfelder, col. 10, lines 55-65.

Regarding claim 8, that the substrate "is formed by two adhesive portions..." is a process limitation in a product claim. Process limitations add no patentable weight in a product claim. See MPEP 2113.

Claim 12 (new) is rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 3922435 to Asnes in view of USPN 5,795,425 to Brault et al., USPN 5,925,431 to Schoenfelder, and further in view of USPN 5,681,644 to Dressler.

Asnes as applied above essentially teaches the claimed invention. Asnes does not teach a second adhesive layer between two adhesive layers a printed marking. However Dressler teaches at col. 5, lines 25-68 and Figure 3 a two-layered adhesive printed ink decal (functional equivalent to "second adhesive layer between two adhesive layers a printed marking") for transferring reverse image composites to a substrate. Hence, it would have been obvious to one of ordinary skill in the art to modify the heat transfer of Asnes to further include a second adhesive layer between two adhesive layers a printed marking since Dressler teaches doing so provides a printed reverse image for a substrate.

***Response to Arguments***

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is (703) 305-3809. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Tamra L. Dicus
Examiner
Art Unit 1774

September 30, 2003

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700